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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,744	10/22/2001	Dirk Quintens	27500-10	8435

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,744

Applicant(s)

QUINTENS ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Office Action

Response to Office Action filed on November 17, 2003 has been entered. Claims 1-12 are pending in the application.

Specification

1. Objection to the disclosure because of the informalities has been withdrawn due to amendment.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b); by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3** stand rejected under 35 U.S.C. 102(e) as being anticipated by Sekiguchi (US 6,485,812) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on June 17, 2003 (Paper No. 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1762

5. **Claims 4-6, 9** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (US 6,485,812) in view of Cousin et al (US 4,554,181) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on June 17, 2003 (Paper No. 3).

6. **Claim 7** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (US 6,485,812) in view of Cousin et al (US 4,554,181), as applied above, and further in view of Rabasco (US 6,455,134) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on June 17, 2003 (Paper No. 3).

7. **Claim 8** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (US 6,485,812) in view of Cousin et al (US 4,554,181), as applied above, and further in view of Malhotra et al (US 5,693,410) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on June 17, 2003 (Paper No. 3).

8. **Claim 10** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (US 6,485,812) in view of Mueller (US 4,098,742) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on June 17, 2003 (Paper No. 3).

9. **Claims 11, 12** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (US 6,485,812) in view of Van den Zegel (US 5,693,370) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on June 17, 2003 (Paper No. 3).

Response to Arguments

10. Applicants' arguments filed November 17, 2003 have been fully considered but they are not persuasive.

(A) Applicants argue that Sekiguchi is different from claimed invention of claim 1 wherein the pigment in an absorption layer and a top coat is provided with a water-insoluble polymer. Also teaching of Sekiguchi that a plurality of layers are simultaneously coated in a wet-on-wet fashion is taken by the Examiner out of context because the teaching is strictly referring to the ink receiving layer but not to distinct layers of different compositions of claim 1.

The Examiner respectfully disagrees with this argument. First of all, the top coat of claim 1 is provided with a water-soluble polymer not a water-insoluble polymer. Secondly, claim 1 does **not** recite that a layer (a) is different from layer (b). Claim 1 merely recites that the layer (a) **contains** a pigment and the layer (b) **contains** a water-soluble polymer, and the layers are coated simultaneously wet-on-wet.

It is held that during patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Since Sekiguchi discloses all **recited** elements of claim 1, Sekiguchi does anticipate the claim.

(B) Applicants argue that claimed invention is not obvious over Sekiguchi in view of Cousin et al /Sekiguchi in view of Cousin et al in view of Rabasco/Sekiguchi in view of Cousin et al in view of Malhotra et al because Sekiguchi fails to teach applying multiple distinct layers in wet-on-wet fashion.

The Examiner respectfully disagrees with this argument for the reasons discussed above.

Art Unit: 1762

(C) Applicants argue that claimed invention is not obvious over Sekiguchi in view of Cousin et al in view of Mueller because Sekiguchi fails to teach applying multiple distinct layers in wet-on-wet fashion. And although Mueller does teach that a coating formulation having surface tension higher than that of a substrate does not wet the substrate, Mueller also provides guidance how to avoid wetting by aqueous or organic based solutions. Therefore, Applicant is at a loss to explain how specifically teaching one skilled in the art to avoid wetting could be used to teach just the opposite in an ink jet film specifically designed to be readily wetted by ink.

The Examiner respectfully disagrees with this argument. Sekiguchi was discussed above. Mueller was cited not for his invention how to avoid wetting. Mueller was cited to show that **it is commonly known** that a coating formulation having surface tension higher than that of a substrate does not wet the substrate, so that one skilled in the art would have guidance how to wet a surface.

(D) Applicants argue that because Sekiguchi teaches away from the use of simultaneous coating of a plurality of layers with different compositions for the coating of ink-receiving layers and Van den Zegel teaches a method for providing a radiographic silver halide material in which hydrophilic layers are coated simultaneously by a slide-hopper coating technique or a slide-hopper curtain coating technique, Sekiguchi and Van den Zegel are from disparate fields, and one skilled in the art would not be motivated to consider combining their teachings.

First of all, Sekiguchi does not teach that simultaneous coating wet-on-wet can be done only with identical compositions. Therefore, Sekiguchi does not teach away from the use of simultaneous coating of a plurality of layers with different compositions for the coating of ink-

receiving layers. Secondly, Van den Zegel teaches that slide-hopper technique and the slide-hopper curtain coating technique which he used for simultaneous coating of hydrophilic layers on a substrate are the well-known techniques, which have been described e.g. in EP's 0 051 238; 0 107 818; 0 300 098; DE 3 238 904; JP-A 04 001 635; WO 94/029769 and U.S. Pat. Nos. 4,191,213; 4,313,980; 4,384,015; 4,569,863; 4,877,639; 4,942,068 and 5,264,339, without however being limited thereto" (See column 2, lines 48-58). In other words, well-known slide-hopper technique and the slide-hopper curtain coating technique can be used for very different compositions, not just for hydrophilic layers of Van den Zegel. US 5,264,339, for example, uses them for coating a **gelatin** containing layer (See column 1, lines 32-41). Therefore, Sekiguchi and Van den Zegel are not from disparate fields as the use of well-known techniques are concerned.

One of ordinary skill in the art at would be motivated to use slide-hopper technique and the slide-hopper curtain coating technique for simultaneous coating wet-on-wet in Sekiguchi because they are well-known techniques for simultaneous coating.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1762

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30, Mo-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, appearing to read 'ETsoy', is written in dark ink.

Elena Tsoy
Examiner
Art Unit 1762

January 29, 2004